

R E M A R K S

Information Disclosure Statement

Under the heading of "Information Disclosure Statement" in item nos. 3 and 4 on page 2 of the Office Action, it was stated that the documents set forth on pages 37 and 38 of the AMENDMENT UNDER 37 CFR 1.111 filed April 6, 2009 did not comply with 37 CFR 1.98(a)(1). This statement is erroneous for the following reasons.

37 CFR 1.98 concerns the contents of an Information Disclosure Statement. The documents listed on pages 37 and 38 of the AMENDMENT UNDER 37 CFR 1.111 filed April 6, 2009 were not intended to be submitted as part of an Information Disclosure Statement, but rather as "evidence." The Examiner's attention is directed to MPEP 609.05(c), which states as follows:

"Occasionally, documents are submitted and relied on by an applicant when replying to an Office Action. These documents may be relied on by an applicant, for example, to show that an element recited in the claim is operative or that a term used in the claim has a recognized meaning in the art. Documents may be in any form but are typically in the form of an affidavit, declaration, patent, or printed publication.

To the extent that a document is submitted as evidence directed to an issue of patentability raised in an Office Action, and the evidence is timely presented, applicant need not satisfy the requirements of 37 CFR 1.97 and 37 CFR 1.98 in order to have the examiner consider the information contained in the document relied on by applicant. In other words, compliance with the information disclosure rules is not a threshold requirement to have information considered when submitted by applicant to support an argument being made in reply to an Office Action."

Claim Amendments

The above amendments to claims 1 and 2 are supported by applicants' Example 3 (see the last two lines on page 17 of the specification).

Applicants' Presently Claimed Invention

Applicants' claim 1 is directed to a surface protective sheet having a pressure-sensitive adhesive layer on at least one side of a substrate; wherein, the pressure-sensitive adhesive comprises 100 parts by weight of a styrene-isobutylene block copolymer, and 100 to 300 parts by weight of a softening agent and 0 to less than 20 parts by weight of a tackifying resin, both

based on 100 parts by weight of the styrene-isobutylene block copolymer.

Applicants' claim 2 concerns a surface protective sheet having a pressure-sensitive adhesive on at least one side of a substrate; wherein, the pressure-sensitive adhesive comprises 200 parts by weight of a thermoplastic elastomer composed of a styrene-isobutylene block copolymer and a styrene block copolymer or a styrene random copolymer other than the styrene-isobutylene block copolymer, and 100 to 300 parts by weight of a tackifying resin, based on 100 parts by weight of the thermoplastic elastomer.

Obviousness Rejections Under 35 USC 103

Claims 1 to 4, 6 and 7 were rejected under 35 USC 103 as being unpatentable over Japanese Patent Application Publication 2000-160121 to Kitayama et al. in view of Japanese Patent Application Publication H09-176581 to Ooshima et al. (see item no. 5 on page 3 of the July 30, 2009 Office Action).

It was admitted in item no. 24 at the bottom of page 6 of the January 7, 2009 Office Action that Kitayama et al. do not

specify how much softener should be added.

Regarding applicants' claim 4, it was admitted in item no. 27 near the bottom of page 7 of the January 7, 2009 Office Action that Kitayama et al. in view of Ooshima et al. do not teach that the melt flowrate of the pressure-sensitive adhesive is 0.5 to 300 g/10 min. at 190°C and 2.16 kg.

Regarding applicant's claim 6, it was admitted in the January 7, 2009 Office Action that Kitayama et al. do not teach the addition of softening agents selected from the group consisting of oil, paraffin was, polyisobutylene and low molecular weight poly- α -olefin.

Applicants' present claims recite an amount of the softening agent to be 100 to 300 parts by weight.

Kitayama et al. do not specify how much of a softening agent should be added.

Ooshima et al. teach that the softening agent should be between 2 and 40 parts by weight (or 0.5 to 40 parts by using a low molecular weight PE wax, and paraffin was softeners) (see paragraph 0017 of Ooshima et al.). Further, Ooshima et al. state clearly "when the amount is 40 parts by weight or more," a glue

residue is likely to remain (see paragraph 0017 of Ooshima et al.).

Therefore, if a person of ordinary skill in the art attempts to modify the adhesive composition of Kitayama et al. in view of Ooshima et al., the person of ordinary skill in the art would add a softening agent in the amount of only 2 to 40 parts by weight (or 0.5 to 40 parts) to the adhesive composition of Kitayama et al. The person of ordinary skill in the art thus would not arrive at applicants' claimed invention.

Accordingly, it is respectfully submitted that applicants' present claims 1 and 2, comprising a softening agent of 100 to 300 parts by weight, are not obvious over JP 2000-160121 (Kitayama et al.) in view of JP H09-176581 (Ooshima et al.).

Applicants' claim 3 depends on claim 2, and applicants' claims 4 to 7 depend on any one of claims 1 to 3. Thus, it is respectfully submitted that claims 3, 4, 6 and 7 also are not obvious over JP 2000-160121 (Kitayama et al.) in view of JP H09-176581 (Ooshima et al.).

Claims 5 to 8 were rejected under 35 USC 103 as being unpatentable over Japanese Patent Application Publication 2000-

160121 to Kitayama et al. in view of Japanese Patent Application Publication H09-176581 to Ooshima et al. and further in view of European Patent Publication EP 0955346 to Ichimura et al. (see item no. 7 on page 3 of the July 30, 2009 Office Action).

It was admitted in item no. 35 near the bottom of page 9 of the January 7, 2009 Office Action that regarding claim 5, Kitayama et al. in view of Ooshima et al. do not specifically teach that the tackifying resin is composed of hydrogenated rosin ester resin.

It was admitted in item no. 38 at the bottom of page 10 of the January 7, 2009 Office Action that regarding claim 5, Kitayama et al. in view of Ooshima et al. do not teach the addition of an antioxidant, an ultraviolet absorber, an ultraviolet stabilizer, an antistatic agent or a lubricant to the pressure-sensitive adhesive.

Applicants' claims 5 to 8 depend on any one of claims 1 to 3. As asserted above, it is respectfully submitted that applicants' claims 1 and 2 patentably distinguish over Kitayama et al. in view of Ooshima et al. It follows that applicants' claims 5 to 8 patentably distinguish over Kitayama et al. in view

of Ooshima et al.

Ichimura et al. also do not specify how much softening agent should be added. Therefore, in view of Ooshima et al., a person of ordinary skill in the art would add a softening agent in an amount of only 2 to 40 parts by weight (or 0.5 to 40 parts) to modify the adhesive composition of Kitayama et al., and would not add a softening agent of more than 40 parts by weight as discussed above. Accordingly, the combination of references would not lead one of ordinary skill in the art to applicants' claims 5 to 8.

Accordingly, it is respectfully submitted that applicants' present claims 5 to 8 are not obvious over JP 2000-160121 (Kitayama et al.) in view of JP H09-176581 (Ooshima et al.) and EP 0 955 346 (Ichimura et al.).

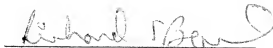
Withdrawal of each rejection under 35 USC 103 is therefore respectfully requested.

Reconsideration is requested. Allowance is solicited.

If the Examiner has any questions, comments, objections or recommendations, the Examiner is invited to telephone the

undersigned at the telephone number given below for prompt
action.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Richard S. Barth", is written over a horizontal line.

RICHARD S. BARTH
REG. NO. 28,180

FRISHAUF, HOLTZ, GOODMAN & CHICK, P.C.
220 FIFTH AVENUE, 16th FLOOR
NEW YORK, NEW YORK 10001-7708
Tel. Nos. (212) 319-4900
(212) 319-4551/Ext. 219
Fax No. (212) 319-5101
E-Mail Address: BARTH@FHGC-LAW.COM
RSB/ddf